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10/611,617	06/30/2003	Bryan Y. Roe	42P15965	1380
59796	7590	11/16/2007	EXAMINER	
INTEL CORPORATION			VO, TED T	
c/o INTELLEVATE, LLC				
P.O. BOX 52050			ART UNIT	PAPER NUMBER
MINNEAPOLIS, MN 55402			2191	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/611,617

Applicant(s)

ROE ET AL.

Examiner

Ted T. Vo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to the amendment filed on 08/22/2007.

Claims 1-18 are pending in the application.

Response to Arguments

2. With regard to the specification of the present application, and Applicants' remarks filed on 8/22/07: Applicants argument is not persuasive.

Because the specification does not disclose its purpose, it is not know what the claimed subject matter presenting in the specification is. It would respectfully require to modify the brief summary of the invention and to restrict the descriptive matter so that they are confined to and in harmony with the invention to which the claims, if allowed, are directed. See MPEP § 1302.01.

With regard to the arguments of the rejected claims 1-18, now amended with "without utilizing a control point stack", as remarked in p. 6:

It should be noted that the rejection of claims being anticipated by a prior art is proper if the prior art reference discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76, 77 USPQ2d 1321, 1325-26 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992). Anticipation of a patent claim requires a finding that the claim at issue "reads on" a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346, 51 USPQ2d 1943, 1945 (Fed. Cir. 1999) ("In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.") (internal citations omitted).

It should be noted that the obviousness for being combined under 103 is proper if an articulated reasoning with some rational underpinning to support the legal conclusion of obviousness'... [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

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Therefore, it would direct the limitation "without" to (MPEP 2131.05):

A reference is no less anticipatory if, after disclosing the invention, the reference then disparages it. The question whether a reference "teaches away" from the invention is inapplicable to an anticipation analysis. *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The prior art was held to anticipate the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed."). >See *Upsher-Smith Labs. v. PamLab, LLC*, 412 F.3d 1319, 1323, 75 USPQ2d 1213, 1215 (Fed. Cir. 2005) (claimed composition that expressly excluded an ingredient held anticipated by reference composition that optionally included that same ingredient); < see also *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1349, 51 USPQ2d 1943, 1948 (Fed. Cir. 1999) (Claimed composition was anticipated by prior art reference that inherently met claim limitation of "sufficient aeration" even though reference taught away from air entrapment or purposeful aeration.)

Specification

3. This Specification remained objected to under 37 CFR 1.77, as it is addressed in the prior office action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that the specification fails to point out clearly what it regards in the invention.

Claims recite generating custom source, tailored to the device, without utilizing a control point stack, to sufficiently implement the control point on the device based on at least one of the device-specific information and the platform information. As noted that the specification fails to point out the scope of the

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invention, while claims as a method comprising, "... " included with this recitation. However, in order to function "without utilizing a control point stack", the claims fails to show inter-steps for how it can perform or can be performed "without". The claims merely preempt for covering everything. Thus, it is unknown the boundary of generation step, and how it could be achieved without using a control point stack.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-18 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-26 of copending Application No. 10/365,230 (Pub. No. 2004/0158823 A1). This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in Claim 1-18, of this instant application, for example claim 1,

A method, comprising: accessing at least one of device-specific and/or platform information for a device that will implement a Universal Plug and Play (UPnP) control point; and generating custom source code, tailored to the device, to efficiently implement the control point on the device based on at least one of the device-specific information and the platform information.

is recited in the copending application. For example claim 1 of the copending application:

A method for generating a custom Universal Plug and Play ("UPnP") application for a device, comprising: accessing device-specific information for the device; accessing platform information for the device; and generating source code based on at least one of the device-specific information and the platform information.

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The claimed subject matters claimed in this instant application is further identified in **copending Application No. 10/365,230**, independent Claims 1, 7, 13, and 19, and their dependent claims.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A person shall be entitled to a patent unless –

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3, 7, 9, 13, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Corporation, "Hosting Devices on Windows XP Using Universal Plug and Play", 5-2002, in view of UPnP™ Forum, "Universal Plug and Play Device Architecture", version 1.0, June 2000 (pp:1-46).

Given the broadest reasonable interpretation of followed claims in light of the specification.

As per Claim 1: Microsoft discloses,

A method, comprising:

accessing at least one of device-specific and/or platform information for a device that will

implement a peer-to-peer network connectivity control point (See p.1 (Control point API), see p. 2

"Device Host API"); and

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generating custom source code (COM objects, compliant UPnP derives, or device object), ***tailored to the device, without utilizing a control point stack, to efficiently implement the control point on the device based on at least one of the device-specific information and the platform information***

(See P. 1, "Introduction". See p. 2, "Implementing the service and Device Control Objects", referring to COM objects, compliant UPnP derives, or device object (Figure in p.4) = *source code*. Also it is noted for the limitation "without": See *Upsher-Smith Labs. v. PamLab, LLC*, 412 F.3d 1319, 1323, 75 USPQ2d 1213, 1215 (Fed. Cir. 2005)(claimed composition that expressly excluded an ingredient held anticipated by reference composition that optionally included that same ingredient)).

Microsoft does not explicitly address, *tailored to the device without utilizing a control point stack*.

The UPnP™ Forum, discloses a standard device platform information, where it discloses by showing a vendor who can build the device separately (See p. 1:What is UPnP?: fourth paragraph:" UPnP devices can be implemented using any programming language, and on any operating system. UPnP does not specify or constrain the design of an API for applications running on control points; OS vendors may create APIs that suit their customer's needs. UPnP enables vendor control over device UI and interaction using the browser as well as conventional application programmatic control." .

Therefore, it is obvious to ordinary in the art that the implicit feature not addressed in the Microsoft reference can be included as it addressed in UPnP™ Forum for having the same and predictable result.

(Note: The obviousness for being combined under 103 is proper if an articulated reasoning with some rational underpinning to support the legal conclusion of obviousness'... [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

As per Claim 3: Microsoft discloses, *The method according to claim 1 wherein accessing the device-specific information further comprises accessing at least one of a device description and a service description for the device* (See Microsoft Windows XP includes UPnP (*platform information*) through a Control point API, p. 1).

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As per Claims 7, 13: The claims are article, and apparatus, that have the limitations address corresponding the functionality of the method Claim 1. See rationale addressed in Claim 1.

As per Claims 9, 15: See rationale addressed in Claim 3.

9. Claims 2, 4-5, 8, 10-11, 14, 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Corporation, "Hosting Devices on Windows XP Using Universal Plug and Play", 5-2002, in view of UPnP™ Forum, "Universal Plug and Play Device Architecture", version 1.0, June 2000 (pp:1-46), and further in view of Aho et al, "Compilers Principles, Techniques, and Tools", 1998.

Given the broadest reasonable interpretation of followed claims in light of the specification.

Regarding limitations of Claims 2, 4-5, 8, 10-11, 14, 17-18: Microsoft and UPnP™ Forum do not explicitly teach compiling the device code generated by the developer.

However, compiling a source code is only conforming to the requirement, where a high level source requires compiling into executable code because the computer cannot run the high level source code.

Aho, teaches compiling in the Claims:

As per claim 2: Aho discloses, *The method according to claim 1 further comprising compiling the source code to generate the custom UPnP control point.* A conventional compiling technique per se. A compiler is to compile source code programmed by a programmer. See Aho reference, particularly, p. 1.

As per claim 4: Aho discloses, *The method according to claim 1 wherein accessing the device-specific information further comprises receiving device-specific information from a programmer.* A conventional compiling technique, that is input data per se. See Aho reference, particularly, p. 1.

As per claim 5: Aho discloses, *The method according to claim 1 wherein generating the source code further comprises enhancing the source code for the control point.* A conventional compiling technique per se; i.e. when compiling, the optimize phase will enhance the source code. See Aho reference, particularly, p. 10, Fig. 1.9.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include, "compiling the source code", recited in such manners in Claims 2, 4-5, with the teaching

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"generating device code" of Microsoft/UPnP™ Forum, because compilation is a requirement for execution, where the inclusion of compilation provides predictable results.

As per Claims 8, 14: Claimed functionality is corresponding to claim 2. See rationale addressed in the rejection of Claims 2, 4-5 above.

As per Claims 10, 17 Claimed functionality is corresponding to claim 4. See rationale addressed in the rejection of Claims 2, 4-5 above.

As per Claims 11, 18: Claimed functionality is corresponding to claim 5. See rationale addressed in the rejection of Claims 2, 4-5 above.

10. Claims 6, 12, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable as being unpatentable over Microsoft Corporation, "Hosting Devices on Windows XP Using Universal Plug and Play", 5-2002, in view of UPnP™ Forum, "Universal Plug and Play Device Architecture", version 1.0, June 2000 (pp:1-46), and further in view of Aho et al, "Compilers Principles, Techniques, and Tools", 1998, and further in view of Microsoft. .

Regarding limitations of Claims 6, 12, and 16, Microsoft/UPnP™ Forum further disclose XML descriptions that require a parser as further recited in claims 6, 12, and 16.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a parser as disclosed in the Microsoft reference for conforming to the requirement, where the adding of the parser giving predictable result.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ted T. Vo whose telephone number is (571) 272-3706. The examiner can normally be reached on 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y. Zhen can be reached on (571) 272-3708.

The facsimile number for the organization where this application or proceeding is assigned is the Central Facsimile number **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTV
October 29, 2007


TED VO
PRIMARY EXAMINER